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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/614,919 | 07/12/2000 | Koichi Sakamoto | 879-268P | 2489 |

7590 03/30/2005
BIRCH, STEWART, KOLASCH & BIRCH, LLP
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Falls Church, VA 22040-0747

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| EXAMINER |
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GENCO, BRIAN C

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| ART UNIT | PAPER NUMBER |
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2615

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,919

Applicant(s)

SAKAMOTO ET AL.

Examiner

Brian C Genco

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 10, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-11 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2004 has been entered.

Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

Examiner thanks Applicant for amending Fig. 2 so as to include the essential material of depressing the audio regeneration button.

Applicant's arguments with regards to the drawing objection to Fig. 5 are herein deemed persuasive and as such the drawing rejection is withdrawn.

Examiner thanks Applicant for amending the specification so as to provide support for originally filed claim 7. As such, the objection to the specification is withdrawn.

Allowable Subject Matter

Claims 3-11 are herein deemed allowable over the prior art of record, the reasons for allowance are as follows:

In regards to claim 3, the prior art of record does not disclose nor fairly suggest a recording and regenerating method of an electronic camera, comprising the steps of recording, in the second recording medium, audio regeneration data which indicates where the non-ambient sound is stored within the first recording medium at the image capturing, and regenerating the non-ambient sound at the image-capturing in accordance with the audio regeneration data which is recorded together with the image data in the second recording medium and also in accordance with the non-ambient audio data which is recorded in the first recording medium in combination with the other claim elements.

Examiner notes that in the prior art references of record the regenerated audio data which is recorded in a first recording medium to the claimed second recording medium. In particular, Kobayashi discloses receiving audio data that is recorded on an inherent first recording medium through input terminal 132 of Fig. 2. The audio data is subsequently recorded on the memory card element 102 of Fig. 2 along with the image data. As such, while audio regeneration data which indicates where the non-ambient sound is stored within the second recording medium is generated when recording the audio data and image data, there is no audio regeneration data which indicates where the non-ambient sound is stored within the first recording medium. In particular, while Kobayashi discloses to record where the audio data is stored in memory card 102 such that the image data and audio data can be played back together there is no disclosure that Kobayashi's invention records where the audio data is recorded on the inherent recording medium of terminal 132.

Similar logic is applied to the Satoh reference. Satoh also discloses an embodiment wherein there is an external audio regeneration device 200 as depicted in Figs. 13 and 14,

Art Unit: 2615

however this audio regeneration device does not have a memory of its own. Namely the audio data that is input to device 200 through input line 207 or microphone 208 is sent to the camera 100 for storage in the recording medium 10 of Fig. 12. As such, there is no audio regeneration data indicating where the non-ambient sound is stored within the first recording medium, since it is stored within the second recording medium along with the image data. Examiner has not discovered any motivation to place a separate memory in the audio regeneration device 200 of Fig. 13.

Claims 4-11 depend from claim 3.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by (US PG-PUB 2002/0054218 to Kobayashi et al.).

In regards to claim 1 Kobayashi discloses an electronic camera, comprising:

Art Unit: 2615

an imaging part which captures a subject image (e.g., element 122 of Fig. 6);

a recording medium which records captured image data of the subject image (e.g., element 102 of Fig. 6); and

an audio regeneration device which regenerates non-ambient sound (e.g., elements 102, 136, 137, 265A, 265B, and 266-269; paragraph 0092; wherein audio data recorded on the memory card 102 is non-ambient audio data input through terminal 132; paragraph 0087), wherein when the subject image is captured, audio regeneration data which at least indicates where non-ambient sound during audio regeneration is stored within the audio regeneration device is recorded in the recording medium together with the captured image data (e.g., paragraph 0052).

In regards to claim 2 Kobayashi discloses an electronic camera, comprising:

an imaging part which captures a subject image (e.g., element 122 of Fig. 6);

a recording medium which records captured image data of the subject image (e.g., element 102 of Fig. 6);

at least one of a display which displays an image in accordance with the image data recorded in the recording medium and an image signal output device which externally outputs an image signal in accordance with the image data recorded in the recording medium (e.g., element 158 of Fig. 6; also, elements 259 and 264 of Fig. 6); and

an audio regeneration device which regenerates non-ambient sound (e.g., elements 102, 136, 137, 265A, 265B, and 266-269; paragraph 0092; wherein audio data recorded on the memory card 102 is non-ambient audio data input through terminal 132; paragraph 0087),

wherein the image data and audio regeneration data recorded in the recording medium are read out, and the image is displayed in accordance with the image data while regenerating non-ambient sound stored within the audio regeneration device at image-capturing in accordance with the audio regeneration data stored within the recording medium (e.g., paragraphs 0052 and 0079).

Conclusion

In order to expedite the prosecution of the instant invention the Examiner suggests amending claim 1 so as to remove the alternative limitation of an audio regeneration device and to exclusively claim the communication device which communicates with an external device which performs audio regeneration and further to edit the newly added limitation of claim 1 to read "within the external device" instead of within the audio regeneration device. Similarly, Examiner suggests amending claim 2 so as to remove the alternative of the audio regeneration device and to exclusively claim the communication device which communicates with an external device which performs audio regeneration and further to edit the newly added limitation of claim 2 to read "stored within the external device" instead of within the audio regeneration device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 571-272-7364 or by fax at 571-273-7364. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached at 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco
Examiner
Art Unit 2615

March 29, 2005



TUAN HO
PRIMARY EXAMINER